

REMARKS

Claims 1 through 4 are currently pending in the application.

Claims 1 through 3 are rejected.

Claim 4 is withdrawn from consideration.

This amendment is in response to the Office Action of September 18, 2006.

35 U.S.C. § 112 Claim Rejections

Claims 1 through 3 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants have amended independent claims 1 and 3 to describe their invention as described in the specification in such a way as to reasonable convey to one skilled in the art that the inventors had in their possession the invention at the time the application was filed.

Applicants assert that independent claims 1 and 3 include the subject matter of numbered paragraphs [0064] through [0071]. Applicants assert that the presently amended independent claims 1 and 3 clearly comply with the provisions of 35 U.S.C. § 112, first paragraph, as busses 90 are illustrated in drawing Fig. 11 and drawing Fig. 12 located on panel 112 of cage 84.

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicant has canceled claim 2.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on Burns (U.S. Patent 5,566,051)

Claims 1 through 3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Burns (U.S. Patent 5,566,051).

Applicants assert that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Brothers v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

Applicants assert that the Burns reference does not and cannot anticipate the claimed inventions of presently amended independent claims 1 and 3 under 35 U.S.C. § 102 because the Burns reference does not identically describe, either expressly or inherently, each and every element of the claimed invention in as complete detail as contained in the claims. Applicants assert that the Burns reference does not describe the elements of the claimed inventions calling for "providing the cage including an open top, an open bottom, at least three attached adjacent peripheral sides and two other peripheral sides, each of the two other peripheral sides attached to one of two of the at least three attached adjacent peripheral sides, one interior wall of one side of the attached adjacent peripheral sides having a plurality of conductive buses located thereon, the cage enclosing at least three adjacent peripheral sides of the plurality of sides of each primary integrated circuit package of the stacked plurality of primary integrated circuit packages" and "providing a cage including an open top, an open bottom, at least three attached adjacent peripheral sides and portions of a fourth peripheral side attached to each of two of the at least three attached adjacent peripheral sides, one interior wall of one side of the attached adjacent peripheral sides having a plurality of conductive buses located thereon, the cage enclosing at least three adjacent sides of the plurality of sides of each primary integrated circuit package of the stacked plurality of primary integrated circuit packages, each primary integrated circuit package having opposed leads extending from opposed sides thereof". Applicants assert that the Burns reference contains no description of such elements whatsoever. Accordingly, presently amended independent claims 1 and 3 are allowable.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Burns (U.S. Patent 5,566,051) in view of Nishino (U.S. Patent 5,343,075)

Claims 1 through 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burns (U.S. Patent 5,566,051) in view of Nishino (U.S. Patent 5,343,075). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art.

The Burns patent teaches or suggests a transfer molded casing.

The Nishino reference teaches or suggests a composite stacked semiconductor device having semiconductor devices having external leads projecting from opposite sides thereof in contact with contact plates.

Applicants assert that any combination of the Palagonia reference and the Nishino reference fails to teach or suggest the claim limitations of the claimed inventions of presently amended independent claims 1 and 3 calling for "providing the cage including an open top, an open bottom, at least three attached adjacent peripheral sides and two other peripheral sides, each of the two other peripheral sides attached to one of two of the at least three attached adjacent peripheral sides, one interior wall of one side of the attached adjacent peripheral sides having a plurality of conductive buses located thereon, the cage enclosing at least three adjacent peripheral sides of the plurality of sides of each primary integrated circuit package of the stacked plurality

of primary integrated circuit packages" and "providing a cage including an open top, an open bottom, at least three attached adjacent peripheral sides and portions of a fourth peripheral side attached to each of two of the at least three attached adjacent peripheral sides, one interior wall of one side of the attached adjacent peripheral sides having a plurality of conductive buses located thereon, the cage enclosing at least three adjacent sides of the plurality of sides of each primary integrated circuit package of the stacked plurality of primary integrated circuit packages, each primary integrated circuit package having opposed leads extending from opposed sides thereof". Applicants assert that any combination of the Burns reference and the Nishino reference teaches or suggests the use of a closed cage not having a conductor on the side thereof but an independent conductor contacting the leads of the printed circuit board to which the leads are fixed. Such is not the claimed inventions of presently amended independent claims 1 and 3. Accordingly, any combination of the Burns reference and the Nishino reference fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the claimed inventions of presently amended independent claims 1 and 3.

Applicants submit that claims 1 and 3 are clearly allowable over the cited prior art.

Applicants request the allowance of claims 1 and 3 and the case passed for issue.

Respectfully submitted,



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